

Claims 1-12 are now in the application. Claims 1-5 and 7-8 have been amended. Claims 11-12 have been added.

In item 1 on page 2 of the above-identified Office action, the drawings have been objected to for not showing certain features under 37 CFR 1.83(a). More specifically, the Examiner has stated that the following recited features :

"outer peripheral border region ... in a latched state"

"free gap ... being open toward said border region, bounded inwardly by said inner contour and by said expandible shaped element and having a shape corresponding substantially to said shaped element"

"latching devices ... integrally formed on said second half-shell and on which said latching cylinder is to be latched.

"latching devices are integrally formed on an outer surface of one of said half-shells";

must be shown. Fig. 4 of the drawings has been amended as to include reference numerals indicating the above features. The feature "outer peripheral border region ... in a latched state" has the reference numeral 15. The feature "free gap ... being open toward said border region, bounded inwardly by said inner contour and by said expandible shaped element and having a

shape corresponding substantially to said shaped element" is formed by the material free spaces which have the reference numerals 6 and 7. The features "latching devices ... integrally formed on said second half-shell and on which said latching cylinder is to be latched" and "latching devices are integrally formed on an outer surface of one of said half-shells" are recited in claims 7 and 8. (Since claims 7 and 8 have been cancelled, the above-noted rejection is moot in regard to these features.)

The Examiner's comments were noted and new drawings showing the these features have been entered.

In item 3 on page 2 of the Office action, claims have been rejected as being indefinite under 35 U.S.C. § 112, first paragraph. More specifically, the Examiner has stated that the following recited features:

"outer peripheral border region ... in a latched state"
"free gap ... being open toward said border region, bounded inwardly by said inner contour and by said expandible shaped element and having a shape corresponding substantially to said shaped element"
latching devices ... integrally formed on said second half-shell and on which said latching cylinder is to be latched.
"latching devices are integrally formed on an outer surface of one of said half-shells".

It is hoped that with the new drawing of Fig. 4 these features appear clear and complete to the Examiner.

In item 5 on page 3 of the Office action, claims 1-10 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph. The Examiner's comments were carefully noted and the claims were amended accordingly. In particular claim 1 was amended as to recite the feature "latching device" in order to give proper antecedent basis for this feature in the dependent claims.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, Counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In item 7 on page 5 of the Office action, claims 1, 9, and 10 have been rejected as being anticipated by Miura et al. (US 4,369,608) under 35 U.S.C. § 102.

In item 8 on page 5 of the Office action, claims 1-9 have been rejected as being anticipated by *Hull et al.* (US 5,419,606) under 35 U.S.C. § 102.

In item 9 on page 5 of the Office action, claims 1-9 have been rejected as being obvious over *Berdan et al.* (US 5,353,571) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references. However, claim 1 has been slightly re-written for clarity.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 as amended calls for, *inter alia*:

an expandible shaped element constructed as a contoured ring-like plate; and

a retaining device to be positioned in a cross-sectional region of a cavity for receiving said shaped element, said retaining device having two separately produced half-

shells to be latched to one another at a distance from one another using a latching device;

one of said half-shells having an inner contour;

said half-shells forming an outer peripheral border region therebetween in a latched state; and

said half-shells defining a free gap therebetween being open toward said border region, bounded inwardly by said inner contour and by said expansible shaped element and having a shape corresponding substantially to said shaped element.

Miura et al. disclose a **hardened** thermosetting material bounded to an outer panel. Hence Miura et al. does not disclose an **expansible** element as recited in claim 1.

Regarding Hull et al. the Examiner stated on page 5 of the Office action that Fig. 2 of Hull et al. shows "an expansible shaped element". However, the element is already hardened or already has its final shape. Hence Miura et al. does not disclose an **expansible** element as recited in claim 1.

Regarding Berdan et al. the Examiner stated on page 5 of the Office action that in Berdan et al. the device with the reference numeral 110 is "an expansible element". However,

the device in *Berdan et al.* with the reference numeral 110 is a mere resilient spacer and, therefore, is not an **expansible** element as recited in claim 1.

Clearly, neither *Miura et al.* nor *Hull et al.* show an expansible element or a retaining device with two half-shells retaining the expansible element between the two half-shells, said retaining device having two separately produced half-shells to be latched as recited in claims 1 and 11 of the instant application. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed not to be anticipated by the references.

One underlying inventive concept of the invention of the instant application is to use a retaining device containing expansible material. The retaining device has the effect as stated on page 4, lines 12-20, of the instant application that expansible material "is only provided wherever it is actually required for sealing purposes and, with a predetermined flow direction, can also expand without obstruction in the direction of the hollow-body wall which is to be sealed, while the material flow to the center of the half-shell is bounded by the inner contour provided on one half-shell." The advantages of the recited retaining device are disclosed on page 4, lines 1-10, of the instant application. The references neither disclose or suggest such a retaining

device. Therefore, the invention as recited in claims 1 and 11 of the instant application is believed not to be obvious over *Berdan et al.* or the other references.

It is accordingly believed to be clear that neither *Miura et al.* nor *Hull et al.* show the features of claims 1 and 11. Furthermore, it is accordingly believed to be clear that *Berdan et al.* do not suggest the features of claims 1 and 11. Claim 1 is, therefore, believed to be patentable over the art and since claims 2-9 are ultimately dependent on claim 1, they are believed to be patentable as well. Similarly, claim 11 believed to be patentable over the art and since claim 12 is dependent on claim 1, claim 12 is believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-12 are solicited.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$ 110.00 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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Version with markings to show changes made:

Page 1, lines 12-16, --

The invention relates to a configuration for [separating] sealing or sound-insulating cavities, in particular in a chassis or a body of a motor vehicle [for sealing or sounding], including a retaining device positioned in a relevant cross-sectional region of a cavity for a shaped element made of expandible material.--

Claim 1 (amended). A configuration for separating cavities for sealing or sound-proofing, comprising:

an expandible shaped element constructed as a contoured ring-like plate; and

a retaining device to be positioned in a cross-sectional region of a cavity [for receiving said shaped element], said retaining device having two separately produced half-shells to be latched to one another at a distance from one another using a latching device, said expandible shaped element being retained between said half-shells;

one of said half-shells having an inner contour;

said half-shells forming an outer peripheral border region therebetween in a latched state; and

said half-shells defining a free gap therebetween being open toward said border region, bounded inwardly by said inner contour and by said expansible shaped element and having a shape corresponding substantially to said shaped element.

Claim 2 (amended). The configuration according to claim 1, wherein said half-shells have inner surfaces, and said latching [devices are] device is disposed on said inner surfaces for connecting said half-shells.

Claim 3 (amended). The configuration according to claim 2, wherein [one of] said latching [devices] device is a mushroom-shaped latching element to be arrested in an opening formed in an inner wall of a cavity to be sealed.

Claim 4 (amended). The configuration according to claim 1, wherein said shaped element has material-free spaces in the [vicinity of] area next to said latching [devices] device.

Claim 5 (amended). The configuration according to claim 1, wherein said two half-shells are first and second half-shells, said first half-shell has said inner contour, said second half-shell has a region corresponding to said inner contour,

and said latching devices are disposed [in the vicinity of] within said inner contour and said region of said second half-shell.

Claim 7 (amended). The configuration according to claim 1, wherein said latching [devices are] device is integrally formed on [an outer] a surface of one of said half-shells for connection to an inner wall of a cavity to be separated off.

Claim 8 (amended). The configuration according to claim 1, wherein said latching [devices are] device is integrally formed on [an outer] a border of one of said half-shells for connection to an inner wall of a cavity to be separated off.

Claim 10 (amended). The configuration according to claim 1, wherein said expandible [shaped] element is formed of a material expanding under the influence of heat toward an open side of said gap formed between said half-shells.